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REMARKS

AUG 23 2007

Rejection of Claims and Summary of Response

Claims 1-127 were pending. Claims 1-20, 22-25, 27-33 and 35-127 were rejected under 35 U.S.C. § 102. Claims 21, 26 and 34 were rejected under 35 U.S.C. § 103. Reconsideration and allowance of Claims 1-127 is requested.

Rejection of Claims under 35 U.S.C. § 102

In the Office Action, Claims 1-20, 22-25, 27-33 and 35-127 were rejected under 35 U.S.C. § 102 as being anticipated by Kenner et al. (U.S. Patent No. 5,956,716).

As discussed further below, the Examiner still has not addressed in any Office Action many of the remarks made by Applicant in the Response to Office Action dated March 2, 2006 (hereinafter, the "first Office Action response") and in the Response to Office Action dated December 1, 2006 (hereinafter, the "second Office Action response"). Nor did the Examiner address the issues raised by those remarks during an interview with Applicant's undersigned attorney on August 21, 2007.

Prosecution of this application cannot be advanced unless and until the Examiner responds to all of Applicant's remarks regarding the rejection of claims in this application. In view of the foregoing, Applicant hereby requests an interview with both the Examiner and the Supervisory Primary Examiner for this application in order to address the issues raised by Applicant's remarks below and in the first and second Office Action

responses, so that prosecution of this application can be advanced.

In response to Applicant's remarks in the first Office Action response regarding the rejection of Claim 1 in the Office Action dated December 2, 2005 (hereinafter, the "first Office Action"), the Office Action dated June 1, 2006 (hereinafter, the "second Office Action") stated:

Applicant argues that Kenner does not teach or suggest "means for communicating to a client the identity of a node server having the specified content stored thereon, thereby enabling the client to request transmission of the specified content from the node server" as recited in Claim 1 [see Remarks, Pages 4-6].

The examiner respectfully disagrees. Kenner explicitly teaches apparatus for effecting the provision of content over a network comprising means for receiving a request from a client for specified content. For example, Kenner discloses requesting and retrieving video clips by the user at the user multimedia terminal [see Kenner, Abstract and Col. 4, Lines 43-64]. In addition, Kenner further teaches means for communicating to the client the identity of a node server having the specified content stored thereon, thereby enabling the client to request transmission of the specified content from the node server. For example, Kenner discloses communications between the web server and the user terminal for transmitting web page and video clips to the user terminal [see Kenner, Fig. 4 and Col. 22, Line 63 to Col. 23, Line 49].

In the second Office Action response, Applicant stated (emphasis added), in response to those remarks in the second Office Action:

In the first Office Action response, Applicant contended that "Kenner et al. do not teach or suggest 'means for communicating to [a] client the identity of a node server having ... specified content stored theron, thereby enabling the client to request transmission of the specified content from the node server,' as recited in Claim 1," as stated in the above-quoted section of the second Office Action. Whether "Kenner explicitly teaches apparatus for

effecting the provision of content over a network, comprising means for receiving a request from a client for specified content," as further stated in the above-quoted section of the second Office Action is inapposite with respect to that contention.

Moreover, it is not the case that "Kenner ... teaches means for communicating to [a] client the identity of a node server having ... specified content stored thereon, thereby enabling the client to request transmission of the specified content from the node server," as further stated in the above-quoted section of the [first] Office Action. As pointed out in the [first] Office Action response, "[r]ather, Kenner et al. teach that an entity (PIM 22) to which a user terminal (analogous to the "client" in Claim 1) communicates a request for a video (content) creates another entity (DSI 30) which requests transmission of video clips of the video to the user terminal" (see the detailed discussion of the teaching of Kenner et al. at pages 5-6 of the [first] Office Action response and, in particular, the teaching of Kenner et al. at column 7, lines 14-35 of the Kenner et al. patent that is quoted there). As indicated by that teaching, the PIM 22 does not communicate the identity of an entity (the DSI 30 or any other entity) to a user terminal to enable the user terminal to request the transmission of specified content from that entity (or another entity with which that entity communicates).

The above-discussed teaching of Kenner et al., and the remarks in the [first] Office Action response regarding that teaching, were not addressed in the [second] Office Action. Instead, the [second] Office Action merely repeated the contention from the [first] Office Action that "Kenner discloses communications between [a] web server and [a] user terminal for transmitting web page and video clips to the user terminal [see Kenner, Fig. 4 and Col. 22, Line 63 to Col. 23, Line 49]." Even assuming arguendo that Kenner et al. do so teach, such teaching does not constitute teaching or suggestion of the "means for communicating to [a] client the identity of a node server" recited in Claim 1. Column 22, line 63 to column 23, line 49 of the Kenner et al. patent states:

The user can, using the browser software 82 on the user terminal 50, browse the Web, accessing Web pages and selecting links as is known in the art. At some point, the user may wish to access a video clip handled by the subscription service. This is done by accessing a Web page on a content provider's Web server 83 or elsewhere. The

desired clip may or may not be among those the user has subscribed to.

The content provider's Web server 83 can automatically, on the basis of a combination of the user's and the ISP's subscription parameters known to the content provider, create customized Web pages for each user. This procedure is known in the art. Preferably, the custom Web pages can be created on the ISP's regional Web server 68 (part of the PIM 64). Such an action can be undertaken at regular intervals, for example daily or whenever new content is made available to the system, or immediately upon access by a user. By accessing custom Web pages, the user will be informed of what subscription content is available, based on subscription information, contained in the user database discussed above. In this way, the ISP can create a "video guide" set of Web pages containing information the user is interested in, including subscribed-to video clips. The information contained in the ISP's "video guide" can be integrated with the information stored on the user's local SRU 51, thereby providing a seamless view of all content available. By selecting a link on the custom Web pages, the user can request a Web page containing subscription content, which will then be delivered by the system of the invention, even if it is not present within the user's region 81.

At that time, the ISP's Web server 68 (or other Web server 83 or 93) begins to transmit the Web page to the user terminal 50 via traditional means over the Internet 56. Accordingly, data moves from the servcr (e.g. server 83) to the corresponding router 86 to the Internet 56 (across potentially many nodes) to the user's ISP's router 112 to the head-end communication interface 51, and eventually to the terminal 50. A reference to a desired clip is embedded within the HTML of the Web page. When the user's browser 82, e.g. Netscape Navigator, receives the reference, supplied for example within an EMBED tag, an immediate request is made of the Web server 83 to transmit the embedded file.

The type or format of the embedded file is analyzed by the browser 82. Typically, this is indicated by an extension on the filename of the embedded file and is known in the art. If the desired file is a video clip, the local SRU 51 belonging to the terminal 50 and the browser

extension 84 are invoked to receive the data. First, the local SRU 51 intercepts a video ID, a unique identifier specifying the selected clip, which is stored within the EMBED field in the Web page. The local SRU 51 first determines if the desired clip is already stored locally. If not, the local SRU 51 passes the video ID to the PIM 64 associated with the user's terminal 50. The local SRU 51 then awaits authorization from the PIM 64 to proceed with a data transfer.

As can be seen, the foregoing section of the Kenner et al. patent does not teach or suggest the "means for communicating to [a] client the identity of a node server" recited in Claim 1. After content is requested by the user terminal 50, the next communication the user terminal receives is a download of the content (or a communication that the content is not available); the user terminal 50 does not receive an identification of an entity from which the content can be downloaded so that the user terminal 50 can then communicate with that entity to effect the content download. If the Examiner continues to contend that the foregoing section of the Kenner et al. patent teaches the "means for communicating to [a] client the identity of a node server" recited in Claim 1, the Examiner is requested to more particularly identify that teaching.

The Examiner has not adequately addressed Applicant's remarks in the second Office Action response that are reproduced above. In the present Office Action, the only additional remarks made by the Examiner concerning the rejection of Claim 1 are that "[s]ince Kenner teaches the user requests a Web page containing a subscription content from the Web server, it is inherent that there is communicating to the client the identity of a node server having the specified content stored thereon and thereby enabling the client to request transmission of the specified content from the node server." That statement is conclusory, dismissive, and incorrect. Obviously, the subscription content could be transferred to the client without further request from the client. These cursory, inadequate and incorrect additional

remarks by the Examiner are illustrative of the obvious failure by the Examiner to consider and respond to the remarks made in Applicant's Office Action responses.

Regarding Applicant's contention that Kenner et al. do not teach or suggest "means for communicating to [a] client the identity of a node server having ... specified content stored theron, thereby enabling the client to request transmission of the specified content from the node server," as recited in Claim 1, the most that Applicant's undersigned attorney was able to elicit from the Examiner during the interview on August 21, 2007, was that the recitation of the above-quoted means in Claim 1 was not clear and that that means was taught by Kenner et al. at column 23, lines 44-49 of the Kenner et al. patent.

With respect to the first of those two points, during the interview, the Examiner suggested the addition of language to Claim 1 which was completely redundant with respect to the language already used in reciting that means, indicating that the problem lies not with the clarity of that recitation, but, rather, with the Examiner's comprehension of it.

With respect to the second of those two points, Kenner et al. teach, at column 23, lines 44-49 of the Kenner et al. patent:

The local SRU 51 first determines if the desired clip is already stored locally. If not, the local SRU 51 passes the video ID to the PIM 64 associated with the user's terminal 50. The local SRU 51 then awaits authorization from the PIM 64 to proceed with a data transfer.

The Examiner apparently believes that the "PIM 64 associated with the user's terminal 50" is a client to which the identity of a

node server having requested content stored thereon is communicated, thereby enabling the client to request transmission of the requested content from the node server, as in Claim 1. However, that cannot be the case. As stated by Kenner et al. at column 21, lines 20-21 of the Kenner et al. patent, "[t]he user terminal 50 is the device through which a user interacts with the delivery system." The user terminal 50 is the apparatus used to make a request for content, i.e., the user terminal 50 is analogous to the client in Claim 1. Kenner et al. further teach at column 20, lines 35-43 of the Kenner et al. patent:

The system also includes a PIM 64 In a preferred embodiment, the PIM 64 includes a modified Web server 68 and a database management module 69. [The PIM 64 is] connected to a regional head-end backbone 80 within the user's home region 81. The backbone 80 may comprise any of a variety of known physical network components, such as Ethernet and FDDI linked together by assorted switches, bridges, routers, and hubs.

As indicated by the foregoing teaching of Kenner et al., together with the illustration of the system in FIG. 4, the PIM 64 and user terminal 50 are not the same apparatus, but are, instead, different apparatus at different locations on a network. Thus, in accordance with the teaching of Kenner et al., the PIM 64 cannot be a client to which the identity of a node server having requested content stored thereon is communicated, thereby enabling the client to request transmission of the requested content from the node server, as in Claim 1.

Further in response to Applicant's remarks in the first Office Action response regarding the rejection of Claim 1, the second Office Action stated:

Applicant further argues that an architecture for effecting the provision of content over a network as in Claim 1 provides advantages not provided by an architecture as taught by Kenner et al. For example, with an architecture as in Claim 1, the client can evaluate the capabilities of node server(s) to deliver content and request transmission of the content from node server(s) that can best provide the content to the client. For instance, as described in Applicant's specification at page 27, lines 16-35, the client can determine topological proximity of node server(s), evaluate the bandwidth and/or latency performance of node server(s), consider other scheduled content delivery by node server(s), and/or analyze (e.g., trend analysis) operation of node server(s), then select node server(s) for delivery of content to the client based on one or more of those evaluations [see Remarks, Page 6].

The examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the client can evaluate the capabilities of node server(s) to deliver content and request transmission of the content from node server(s) that can best provide the content to the client. For instance, as described in Applicant's specification at page 27, lines 16-35, the client can determine topological proximity of node server(s), evaluate the bandwidth and/or latency performance of node server(s), consider other scheduled content delivery by node server(s), and/or analyze (e.g., trend analysis) operation of node server(s), then select node server(s) for delivery of content to the client based on one or more of those evaluations) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Gruens, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is noted that if the features upon which applicant relies are not recited in the rejected claim 1 as argued by the applicant, then an architecture for effecting the provision of content over a network as in claim 1 cannot provide advantages over an architecture as taught by Kenner.

In the second Office Action response, Applicant stated, in response to those remarks in the second Office Action:

In the [first] Office Action response, Applicant stated that "[a]n architecture for effecting the provision of content over a network as in Claim 1 provides advantages not provided by an architecture as taught by Kenner et al." Applicant then identified advantageous capabilities that are enabled by that architecture. Applicant did not argue that those capabilities are recited in Claim 1, and the statements in the [second] Office Action to the contrary misrepresent Applicant's remarks in the [first] Office Action response. Rather, Applicant noted that the architecture for effecting the provision of content over a network as in Claim 1 (i.e., apparatus that includes "means for communicating to [a] client the identity of a node server having ... specified content stored thereon, thereby enabling the client to request transmission of the specified content from the node server") enables, for example, the client to evaluate the capabilities of node server(s) to deliver content and request transmission of the content from node server(s) that can best provide the content to the client (e.g., the client can determine topological proximity of node server(s), evaluate the bandwidth and/or latency performance of node server(s), consider other scheduled content delivery by node server(s), and/or analyze operation of node server(s), then select node server(s) for delivery of content to the client based on one or more of those evaluations). Applicant identified these advantageous capabilities, which are not enabled by the invention taught by Kenner et al., to highlight the aspect of Claim 1 not taught or suggested by Kenner et al. (as had been previously discussed), i.e., means for communicating to a client the identity of a node server having requested content stored thereon.

The Examiner did not address these remarks at all in the present Office Action. Therefore, unless the Examiner explicitly states to the contrary, Applicant assumes that the Examiner acknowledges and agrees with Applicant's remarks in the second Office Action response reproduced above.

Still further in response to Applicant's remarks in the first Office Action response regarding the rejection of Claim 1, the second Office Action stated:

Applicant also argues that Kenner does not teach or suggest "an owner of a node server can be offered an incentive as compensation for transmission of specified content to a client" as recited in claim 1 [see Remarks, Pages 7-9].

The examiner respectfully disagrees. Kenner further teaches means for ascertaining that the node server transmitted the specified content to the client. That is, Kenner discloses locating audio/video content on servers to transmit to the users [see Kenner, Col. 5, Lines 16-64]. Last but not least, Kenner does teach an owner of the node server is offered an incentive as compensation for transmission of the specified content to the client. For example, Kenner discloses, based on broadest interpretation, drug companies (owner of on-line website) placing advertisements and promotions for downloading the requested audio-visual information of their products [see Kenner, Col. 19, Lines 8-37]. In addition, Kenner discloses the subscription to access to the services may be free (incentive) and some clips might be free (incentive) with an appropriate subscription [see Kenner, Col. 33, Lines 34-57 and Col. 34, Lines 16-28].

In the second Office Action response, Applicant stated, in response to those remarks in the second Office Action:

In the above-quoted section of the [second] Office Action, it is contended that "Kenner discloses locating audio/video content on servers to transmit to the users" and that such description constitutes teaching of means for ascertaining that a node server transmitted specified content to a client. However, that is clearly not the case. Locating audio/video content on servers to transmit to the users simply is not ascertaining that a node server transmitted specified content to a client: identifying that a server has content stored thereon indicates nothing about whether that server actually transmitted the content to another entity. Moreover, whether "Kenner discloses locating audio/video content on servers to transmit to the users" is clearly inapposite with respect to Applicant's contention in the [first] Office Action response, discussed in the above-quoted section of the [second] Office Action, that "Kenner et al. also

do not teach or suggest that an owner of a node server can be offered an incentive as compensation for transmission of specified content to a client, as recited in Claim 1."

Further, contrary to the contention in the [second] Office Action, the statement at column 19, lines 35-37 of the Kenner et al. patent that "drug companies may place advertisements about promotional drugs on the video clips for use by the physician" does not constitute teaching that an owner of a node server can be offered an incentive as compensation for transmission of specified content to a client, as recited in Claim 1. In Example 2 described in the Kenner et al. patent at column 19, lines 8-37, the third party text database can be analogous to the apparatus recited in Claim 1 (i.e., receives requests for content), the physician can be analogous to the client recited in Claim 1 (i.e., makes requests for content), and a drug video can be analogous to the specified content recited in Claim 1. However, the drug companies are not analogous to node server owners and do not operate node servers. The drug companies do not receive requests for content from physicians nor provide content to physicians. To the extent that the capability of placing an advertisement in a drug video is compensation to a drug company, that is compensation for allowing the drug video (which is produced by the drug company) to be provided to physicians (i.e., compensation to a content owner for allowing its content to be provided to others), not compensation for the physical act of providing the drug videos to physicians (i.e., not compensation for transmitting specified content to others).

Additionally, the contention in the [second] Office Action that Kenner et al.'s teaching that "[a] subscription to access to [s]ervices may be free (incentive) and some clips might be free (incentive) with an appropriate subscription [see Kenner, Col. 33, Lines 34-57 and Col. 34, Lines 16-28]" constitutes compensation to a node server is clearly incorrect. Those sections of the Kenner et al. patent concern aspects of subscriptions by end users, i.e., clients. Thus, even assuming arguendo that provision of a free subscription and/or a free clip is compensation, that compensation is to a client, not a node server owner as in the method of Claim 1. Moreover, such "compensation" is not given for transmitting content via a network, as is the case in the method of Claim 1.

The Examiner did not address the foregoing remarks at all in the present Office Action. In order to advance prosecution of this application, the Examiner must consider and respond to the above remarks regarding the rationale for rejecting Claim 1.

In view of the foregoing, Claim 1 is allowable over the teaching of Kenner et al. Claims 2-20, 22-25 and 27-34 each depend, either directly or indirectly, on Claim 1 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 35-51, as stated in the second Office Action response:

For reasons as discussed above with respect to Claim 1, Kenner et al. do not teach or suggest "means for communicating the identity of candidate node servers to [a] client to enable the client to request transmission of ... requested content via [a] network from one or more of the candidate node servers," as recited in Claim 35. In view of the foregoing, Claim 35 is allowable over the teaching of Kenner et al. Claims 36-51 each depend, either directly or indirectly, on Claim 35 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 52-68, as stated in the second Office Action response:

For reasons as discussed above with respect to Claim 1, Kenner et al. do not teach or suggest "means for communicating the identity of ... candidate node servers to [a] client to enable the client to request transmission of ... requested content via [a] network from one or more of the candidate node servers," as recited in Claim 52. In view of the foregoing, Claim 52 is allowable over the teaching of Kenner et al. Claims 53-68 each depend, either directly or indirectly, on Claim 52 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 69-76, as stated in the second Office

Action response:

For reasons as discussed above with respect to Claim 1, Kenner et al. do not teach or suggest "means for communicating the identity of . . . candidate node server television set-top boxes to [a] client television set-top box to enable the client television set-top box to request transmission of . . . requested content via [a] network from one or more of the candidate node server television set-top boxes," as recited in Claim 69. In view of the foregoing, Claim 69 is allowable over the teaching of Kenner et al. Claims 70-76 each depend, either directly or indirectly, on Claim 69 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 77-94, as stated in the second Office

Action response:

[T]he [second] Office Action stated that "Claim 77 is rejected under the same rationale set forth above to claim 1." Claim 77 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 1. Claims 78-94 each depend, either directly or indirectly, on Claim 77 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 95-107, as stated in the second Office

Action response:

[T]he [second] Office Action stated that "Claim 95 is rejected under the same rationale set forth above to claim 35." Claim 95 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 35. Claims 96-107 each depend, either directly or indirectly, on Claim 95 and are therefore allowable as dependent on an allowable claim.

Regarding Claims 108-120, as stated in the second Office

Action response:

[T]he [second] Office Action stated that "Claim 108 is rejected under the same rationale set forth above to claim 52." Claim 108 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 52. Claims 109-120 each depend, either directly or indirectly, on Claim 108 and are therefore allowable as dependent on an allowable claim.

Regarding Claim 121, as stated in the second Office Action response:

[T]he [second] Office Action stated that "Claim 121 is rejected under the same rationale set forth above to claim 1." Claim 121 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 1.

Regarding Claim 122, as stated in the second Office Action response:

[T]he [second] Office Action stated that "Claim 122 is rejected under the same rationale set forth above to claim 35." Claim 122 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 35.

Regarding Claim 123, as stated in the second Office Action response:

[T]he [second] Office Action stated that "Claim 123 is rejected under the same rationale set forth above to claim 52." Claim 123 is allowable over the teaching of Kenner et al. for the same reasons as given above with respect to Claim 52.

Regarding Claim 124, the present Office Action states that "Claim 124 is rejected under the same rationale set forth above to claim 1." Claim 124 is allowable over the teaching of Kenner et al. for the reasons given in the second Office Action response.

Regarding Claim 125, the present Office Action states that "Claim 125 is rejected under the same rationale set forth above to claim 35." Claim 125 is allowable over the teaching of Kenner et al. for the reasons given in the second Office Action response.

Regarding Claim 126, the present Office Action states that "Claim 126 is rejected under the same rationale set forth above to claim 52." Claim 126 is allowable over the teaching of Kenner et al. for the reasons given in the second Office Action response.

Regarding Claim 127, the present Office Action states that "Claim 127 is rejected under the same rationale set forth above to claim 69." Claim 127 is allowable over the teaching of Kenner et al. for the reasons given in the second Office Action response.

In view of the foregoing, it is requested that the rejection of Claims 1-20, 22-25, 27-33 and 35 127 under 35 U.S.C. § 102 be withdrawn.

Rejection of Claims under 35 U.S.C. § 103

In the Office Action, Claims 21, 26 and 34 were rejected under 35 U.S.C. § 103 as unpatentable over Kenner et al. (U.S. Patent No. 5,956,716).

Claims 21, 26 and 34 each depend, either directly or indirectly, on Claim 1 and are therefore allowable over the teaching of Kenner et al. for at least the reasons given above with respect to Claim 1.

In view of the foregoing, it is requested that the rejection of Claims 21, 26 and 34 under 35 U.S.C. § 103 be withdrawn.

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PAGE 19/20

AUG 23 2007

CONCLUSION

Claims 1-127 were pending and were rejected. In view of the foregoing, it is requested that Claims 1-127 be allowed. If the Examiner wants to discuss any aspect of this application, the Examiner is invited to telephone Applicant's undersigned attorney at (408) 945-9912.

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, facsimile number (571) 273-8300, on August 23, 2007.

8-23-07 Date

David R. Graham Signature

Respectfully submitted,

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